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Customer Number

Patent  
Case No.: 58946US004

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Inventor: HARAI, SATOSHI

Application No.: 10/561503

Confirmation No.: 6419

Filed: July 27, 2004

Group Art Unit 1794

Title: DOUBLE-SIDED PRESSURE-SENSITIVE ADHESIVE SHEET

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**REPLY BRIEF**  
**UNDER 37 CFR § 41.41**

Mail Stop: Appeal Brief-Patents  
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10/8/08

/K.J. Rostberg/

Date

Signed by: K.J. Rostberg

Dear Sir:

This is a Reply Brief in response to the Examiner's Answer dated August 29, 2008.

This reply brief is believed to be timely submitted. It is believed that no fee is due; however, in the event a fee is required please charge the fee to Deposit Account No. 13-3723.

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**STATUS OF CLAIMS**

Claims 1-10, 12 and 17-20 were cancelled.

Claims 11, 13-16 and 21-26 are pending.

Claims 11, 13-16 and 21-26 stand rejected.

Claims 11, 13-16 and 21-26 are on appeal.

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**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

- I. Claim 11, 13-16 and 21-26 stand rejected under 35 USC § 102(b) as being anticipated by JP 2002-23663.

**ARGUMENT**

**I. Claim 11, 13-16 and 21-26 stand rejected under 35 USC § 102(b) as being anticipated by JP 2002-23663**

***A. Independent claim 21 and dependent claims 11 and 13-16.***

In response to Appellants' argument that JP '663 fails to disclose two separate adhesive layers and two separate black layers, the Examiner stated "JP '664 clearly discloses that additional layers may be present in the construction of the double sided adhesive, which allows the black layer and the adhesive layer being two distinct layers." (Examiner's Answer, Section 10, page 5.)

Appellants respectfully submit that the mere fact that JP '664 may disclose that additional layers may be present is not a legally sufficient basis for concluding that JP '664 discloses the required two separate adhesive layers and two separate black layers. Absent any specific teaching by JP '664 regarding the nature of such additional layers, the Examiner's conclusion on this matter appears to rely on impermissible hindsight, as the asserted characteristics for these "additional layers" appear to be based solely on Appellants' claimed structure.

***B. Dependent claims 13-16***

The following remarks are provided to correct an error made by Appellants during prosecution of this application.

Claim 13 depends from claim 1 and further requires a reflective layer situated between the second black layer and the second pressure-sensitive adhesive layer. In their response dated April 11, 2008, at page 6 and in the Appeal Brief in Section I(B), Appellants argued "that they were not able to identify any reference [in JP '664] to a black 'protective layer' or any other black layer located **between** a reflective layer and an adhesive layer."

Consistent with the language of claim 13 and the rejection by the Examiner, Appellants' intended to argue that they were not able to identify any reference to a black "protective layer" or any other black layer such that JP '663 described a reflective layer between such a black layer and an adhesive. That is, the claim language requires a reflective language between a black layer and an adhesive layer, not a black layer between a reflective layer and an adhesive layer.

Appellants maintain their arguments set forth in the Appeal Brief regarding the Examiner's failure to show how JP '663 describes this and other elements of claim 13. Notwithstanding

Appellants' error, Appellants believe the Examiner addressed the correct claim language in the Final Office Action and the Examiner's Answer. Appellants apologize for any inconvenience.

October 8, 2008

Date

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